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1 UNITED STATES PATENT AND TRADEMARK OFFICE
2

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex parte* TOSHIHIKO UENO and YOSHIHIRO HOSHINO
8

10 Appeal 2009-004815
11 Application 09/819,459
12 Technology Center 3600
13

14 Decided: December 16, 2009
15

16 *Before* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.
17 FETTING, *Administrative Patent Judges*.
18

19 CRAWFORD, *Administrative Patent Judge*.
20

21 DECISION ON APPEAL
22

1 STATEMENT OF THE CASE

2 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
3 of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

4 Appellants invented systems and methods for data transfer using a
5 mobile terminal and a two-dimensional barcode, and more particularly, a
6 processing system, server, processing terminal, and communications
7 terminal that can be used to pay for purchases and manage membership
8 cards and admission tickets, and other services (Spec. 1:5-8).

9 Claim 1 under appeal is further illustrative of the claimed invention as
10 follows:

11 1. A processing system comprising:

12 a data management server for storing registration
13 information about a customer, the registration information
14 linked to a financial account of the customer with an external
15 financial institution;

16 a customer communication terminal adapted for data
17 communication with said data management server and for
18 outputting information for identifying a customer; and

19 a process execution terminal for receiving said
20 information for identifying the customer from said customer
21 communication terminal and executing a process for said
22 customer, wherein:

23 said process execution terminal provides said information
24 to said data management server when receiving said
25 information for identifying the customer;

26 said data management server identifies the customer
27 based on said information provided from said process execution
28 terminal, generates reply information based on said registration
29 information about said customer, the reply information
30 indicating an approval of payment from the financial account,
31 and provides said reply information to said process execution
32 terminal; and

1 said process execution terminal executes a process for
2 said customer based on said reply information when receiving
3 said reply information;

4 wherein the information for identifying the customer and
5 the registration information about the customer is associated
6 with each other only at the data management server, the data
7 management server being different than the process execution
8 terminal that receives the information for identifying the
9 customer.

10 The prior art relied upon by the Examiner in rejecting the claims on
11 appeal is:

12 Webb US 6,877,661 B2 Apr. 12, 2005
13 Webb US 60/225,805 Aug. 16, 2000
14 (hereinafter “Provisional Application”).

15 The Examiner rejected claims 1-6, 8, 9, 11-18, 20, 21, and 24-28
16 under 35 U.S.C. § 102(b) as being anticipated by Webb; and rejected claims
17 7, 10, 19, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable over
18 Webb.

19
20 ISSUES

21 Whether “the registration information linked to a financial account of
22 the customer with an external financial institution,” as recited in independent
23 claims 1, 6, 11, 17, 21, and 24-28, is non-functional descriptive material?

24 Did the Appellants show the Examiner erred in asserting that
25 dependent claims 7, 10, 19, and 22-23 are allowable due to their dependence
26 on one of allowable independent claims 6, 17, and 21?

FINDINGS OF FACT

Specification

3 Appellants invented systems and methods for data transfer using a
4 mobile terminal and a two-dimensional barcode, and more particularly, a
5 processing system, server, processing terminal, and communications
6 terminal that can be used to pay for purchases and manage membership
7 cards and admission tickets, and other services (Spec. 1:5-8).

8 Registration information may be, for example, the number of
9 customer's credit card, debit card, or bank account for payment (Spec. 4:13-
10 17).

11 Registration information may be customer billing information (e.g.,
12 amount billed, billing date, details of billing, etc). provided to the data
13 management server from the online shopping, mail order, or utility company
14 (Spec. 6:1-5).

15 Card information about a card such as a credit card or customer credit
16 card held by a customer is pre-registered in the wallet center along with
17 personal authentication information, portable terminal identification
18 information, and card select information for selecting a particular card
19 (Spec. 13:5-8, 15-18).

20 The server 30 of the management center has a customer DB (database,
21 data storage) 37 for storing pre-registered customer information. The
22 customer DB 27 contains registration information entered online or by mail
23 by a customer beforehand, including the name and address, and personal
24 information of the customer, telephone numbers of a portable
25 communications terminal 10 held by the customer, the name of the credit
26 institution that the customer wants to use, the number of a card for payment

1 such as a credit card or debit card (hereinafter simply called a “credit card”)
2 of the customer, a bank account number for direct debit and other payment
3 information of the customer. The customer DB 37 also holds status
4 information on the credit card registered by each customer. The status of the
5 credit card registered by the customer is usually “not available” unless
6 access is made by the customer. The status of a credit card selected by the
7 customer and becomes “available” when access is made by the user using a
8 valid password (Spec. 22:8 to 23:1).

9

10 PRINCIPLES OF LAW

11 *Obviousness*

12 Where the printed matter is not functionally related to the substrate,
13 the printed matter will not distinguish the invention from the prior art in
14 terms of patentability. *In re Gulack*, 703 F.2d 1381, 1385-86 (Fed Cir.
15 1983).

16 During examination, the examiner bears the initial burden of
17 establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d
18 1443, 1445 (Fed. Cir. 1992).

19 Once a *prima facie* case of obviousness is established, the burden
20 shifts to Appellant to rebut it. *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

21

22 *Claim Construction*

23 During examination of a patent application, a pending claim is given
24 the broadest reasonable construction consistent with the specification and

1 should be read in light of the specification as it would be interpreted by one
2 of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359,
3 1364 (Fed. Cir. 2004).

4

5 ANALYSIS

6 *Non-Functional Descriptive*

7 Appellants argue that the coupons savings accounts of the Provisional
8 Application of Webb does not correspond to “the registration information
9 linked to a financial account of the customer with an external financial
10 institution,” as recited in independent claims 1, 6, 11, 17, 21, and 24-28
11 (App. Br. 9-12). However, even if neither Webb nor the Provisional
12 Application of Webb disclose the aforementioned aspect, it is non-functional
13 descriptive material, and thus cannot distinguish the invention from the prior
14 art in terms of patentability. *See In re Gulack*, 703 F.2d at 1386-86.

15 Specifically, the aforementioned aspect, when read in view of the
16 Specification, only requires that the registration information include
17 *information* linking the financial account of the customer with the external
18 financial institution. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at
19 1364. An actual link, such as a wire-transfer or Internet link, between the
20 registration information and the financial account is not required. Indeed, as
21 set forth in the Specification, the presence of credit card numbers within the
22 registration information is sufficient to “link” the financial account of the
23 customer with the external financial institution.

24 As the link is merely non-functional descriptive information, it does
25 nothing to alter the underlying operation of either the data management
26 server or the processing system. Accordingly, it cannot distinguish the

1 invention from the prior art in terms of patentability. *See In re Gulack*, 703
2 F.2d at 1386-86.

3 As this rationale for rejecting independent claims 1, 6, 11, 17, 21, and
4 24-28 differ from the rationale set forth by the Examiner, we denominate it a
5 new ground of rejection under 37 C.F.R. § 41.50(b). We also apply this new
6 rationale and new rejection to dependent claims 2-5, 8, 9, 12-16, 18, and 20.

7

8 *Claims 7, 10, 19, 22, and 23*

9 We further apply the new rationale to the obviousness rejection of
10 dependent claims 7, 10, 19 and 22-23 while retaining the Examiner's
11 rationales for rendering the additionally recited aspects of these claims
12 obvious. The Examiner has set forth a proper case of *prima facie*
13 obviousness with respect to those additional aspects on pages 13-14 of the
14 Examiner's Answer. *See In re Oetiker*, 977 F.2d at 1445. The Appellants
15 have not set forth specific arguments as to why the Examiner erred in
16 rendering obvious those additional aspects¹. Accordingly, as Appellants
17 have not met the burden of rebutting Examiner's *prima facie* case of
18 obviousness, we decline to overturn these rejections as they apply to the
19 additional aspects set forth in dependent claims 7, 10, 19 and 22-23. *See In*
20 *re Keller*, 642 F.2d at 426.

¹ The entirety of Appellants' argument consists of "the qualified disclosure of Webb does not suggest a modification of Webb in a manner to teach the claimed invention as represented in claims 7, 10, 19 and 22-23" (App. Br. 12).

CONCLUSION OF LAW

2 On the record before us, Appellants have not shown that the Examiner
3 erred in rejecting claims 1-28.

4 We enter a new ground of rejection of claims 1-28.

DECISION

7 The decision of the Examiner to reject claims 1-28 is affirmed.

8 This decision also contains new grounds of rejection pursuant to 37
9 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of
10 rejection pursuant to this paragraph shall not be considered final for judicial
11 review.” This Decision contains a new rejection within the meaning of 37
12 C.F.R. § 41.50(b) (2007).

13 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO
14 MONTHS FROM THE DATE OF THE DECISION, must exercise one of
15 the following two options with respect to the new rejection:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

25 Should the Appellants elect to prosecute further before the examiner
26 pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek
27 review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,
28 the effective date of the affirmance is deferred until conclusion of the

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1 prosecution before the Examiner unless, as a mere incident to the limited
2 prosecution, the affirmed rejection is overcome.

3 If the Appellants elect prosecution before the Examiner and this does
4 not result in allowance of the application, abandonment or a second appeal,
5 this case should be returned to the Board of Patent Appeals and Interferences
6 for final action on the affirmed rejection, including any timely request for
7 rehearing thereof.

8 No time period for taking any subsequent action in connection with
9 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

10

11 AFFIRMED; 37 C.F.R. § 41.50(b)

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